

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent Application No. 10/753,270

Applicant: Feygenson

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Examiner: Casler, Traci

Docket No.: 225265

Customer No.: 23460

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

APPELLANTS' AMENDED APPEAL BRIEF

Mail Stop Appeal Brief – Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Office Communication dated June 26, 2007, and in support of the appeal from the final rejection dated July 27, 2006, Appellants now submit their Amended Brief. The Amended Brief includes a revised Appendix VIII, which is now a “clean” copy of the existing claims.

I. Real Party In Interest

The patent application that is the subject of this appeal is assigned to American International Group, Inc.

II. Related Appeals and Interferences

U.S. Application Serial Number 11/273,459, which is a divisional of this application, is currently on appeal.

III. Status of Claims

Claims 16-19 and 21-32 are pending. Original claims 1-15 and 20 have been withdrawn. Claims 16-19 and 21-32 stand finally rejected, and these rejections are presently being appealed.

A complete listing of these claims appears in the Claims Appendix.

IV. Status of Amendments

There were no amendments submitted after the final rejection.

V. Summary of Claimed Subject Matter

Claims 16-19 and 21-32, including independent claims 16, 19, and 21, are pending. The summaries of the independent claims reference the specification and drawings filed with the application on January 8, 2004.

Independent claim 16 pertains to a method for accessing, engaging and managing human resources (*see* Figs. 6A-6C). The method includes determining the constituent components of a “task,” which are described in the specification and claims as “atomic units of work.” These work units are activities that a business could not, or would not for practical reasons, further subdivide (*see* p. 2, ¶ 7; p. 12, ¶¶ 46, 48.) Claim 16 further requires that the performed work is capable of being transmitted electronically over the Internet. The availability of atomic units of work is announced to a pool of potential applicants (*see* Fig. 6A, steps 45-52). At least one candidate is thereafter selected from the pool. The method further includes the step of negotiating payment for the completed atomic units of work and paying the candidate the negotiated payment (*see* Fig. 6A, step 44; p. 12, ¶ 47; p. 16, ¶ 59).

Independent claim 19 pertains to a method for completing a task. The method includes separating the “task” into its subparts, some which may be performed on an “atomic units of work” basis. As noted above, atomic units of work are business activities that a business could not, or would not for practical reasons, further subdivide (*see* p. 2, ¶ 7; p. 12, ¶¶ 46, 48). Claim 19 further requires determining which of the subparts are suitable for atomic units of work. At least one candidate is selected to perform each type of atomic units

of work. The method further includes the step of receiving the completed atomic units of work over the Internet and paying the selected candidate for each received unit of work (*see* Fig. 6A, step 44; Fig. 6C, step 62; p. 12, ¶ 47; p. 16, ¶ 59).

Independent claim 21 sets forth a method for utilizing the skills of independent contractors, which are described in the specification as participants of an Extended Work Program (“EWP”) (*see* p. 1, ¶¶ 2-3). As is commonly understood, an independent contractor, like a participant in the EWP, “has freedom to choose work-hours, geographical location, and type of ... work” (*see* p. 1, ¶ 3). The method includes searching a database (*see* Fig. 3, databases 23-25) to identify independent contractors that have skills matching the criteria necessary to complete a type of atomic unit of work (*see e.g.* Fig. 6A, steps 47, 49). Atomic units of work are thereafter offered to the contractors and at least one is selected to actually perform such work (*see* Fig. 6C, step 62). The uncompleted work is distributed to the contractor and completed work is thereafter received from the contractor (*see* Fig. 6C, step 62; p. 16, ¶ 59). Finally, the method includes payment to the contractor for each completed atomic unit of work (Fig. 6A, step 44; p. 12, ¶¶ 46-47).

VI. Grounds of Rejection to be reviewed on Appeal

The grounds of rejection to be reviewed on appeal are the grounds stated in the Final Office Action mailed on April 17, 2006. In particular, Appellants appeal:

1. The rejection of claims 21-32 under 35 U.S.C. 112, as failing to comply with the written description requirement.
2. The rejection of claims 16-18 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,567,784, filed on June 3, 1999 (“Bukow”).
3. The rejection of claims 19 and 21-32 under 35 U.S.C. 103(a) as being obvious over Bukow in view of www.medquist.com, purportedly retrieved from the “Wayback Machine” on June 8, 2003 (“Medquist”).

VII. Argument

Appellants request reversal of the rejection of presently pending claims 16-19 and 21-32 (provided in the Claims Appendix attached hereto) that are directed to a novel and non-obvious method of utilizing the skills of unemployed and underemployed workers. An Extended Work Program (EWP) in accordance with the claims on appeal uses the Internet to identify, employ, manage (including testing, training and evaluation) and compensate workers in a distributed environment. An EWP creates fundamentally different relationships between potential workers and job providers than the traditional employer/employee relationship by determining, distributing and paying for “atomic units of work.” This approach, in contrast to the conventional model, focuses on paying individual participants for completed work as opposed to an hourly rate.

The final rejection of the presently pending claims is improper. The Section 112 rejection of claims 21-32 is improper inasmuch as the specification contains ample written description for the claim term “independent individual contractors.” Second, neither the Bukow nor Medquist references, upon which the final Office Action exclusively relies, describe the “atomic units of work” approach claimed in the present application. Bukow, therefore, cannot anticipate the claims 16-18. In addition, even a hypothetical combination of Bukow with Medquist does not describe atomic units of work. As such, this hypothetical combination fails to render obvious the subject matter set forth in claims 19 and 21-32.

Each of these grounds for Appellants' appeal is addressed further herein below.

Rejection of Claims 21-32 under 35 U.S.C. § 112

The Office Action dated July 27, 2006 rejected claims 21-32 due to the use of the term “independent individual contractor.” According to the Office Action, this term leaves “the claim limitations narrower than that of the specification.”

It was well established prior to the filing date of the present application that an “independent contractor” is “[g]enerally, one who, in exercise of an independent employment, contracts to do a piece of work according to his own methods and is subject to his employers control only as to end product or final result of his work.” *See Black's Law Dictionary*, 6th Ed. (1990). The specification, while not using the exact phrase “independent

individual contractor,” certainly contemplates that participants in the EWP will be independent contractors.

In particular, the specification states “A participant in the EWP has freedom to choose work-hours, geographical location, and type of atomic units of work.” (Specification at p. 1, ¶ 3.) It additionally states “employers may maintain separation from EWP participants” (*see* p. 6, ¶ 28) and “participants may be working for numerous different employers” (*see* p. 6, ¶ 29). The specification further describes an Administrative System that includes an “indirect communication channel” between employers and participants (*see* Fig. 2, ref. num. 11).

Participants in the EWP program, therefore, choose their own hours, locations, types of work, and even employers. In certain circumstances, they do not directly communicate with the employers. As such, the specification contains ample support for individual participants in an EWP program to be considered “independent individual contractors,” as that term is commonly understood. The specification explicitly describes methods and systems in which participants in an EWP have the high degree of independence expected of independent individual contractors.

The rejection of claims 21-32 for lack of written description under 35 U.S.C. § 112 should therefore be reversed.

Rejection of Claims 16-18 under 35 U.S.C. § 102(e)

The Office Action dated July 27, 2006 further rejected claims 16-18 as being anticipated by Bukow. This reference, however, does not disclose the claimed subject matter.

In particular, Bukow does not disclose the “atomic unit of work” approach. Atomic units of work, as described in the specification, may be defined as activities that a business could not, or would not for practical reasons, further subdivide. (Specification at ¶¶ 7, 46-48.) Examples of atomic units of work include reviewing documents for typographical information, processing insurance claims, processing accounts payable, writing software modules, designing circuit components, completing proposals, etc. (*Id.*)

The selection of individuals to perform atomic units of work, along with a negotiation for a payment per unit of work, is not described in Bukow. Bukow discloses a system for

matching projects and workers. It provides no description for the step in claim 19 of “determining several types of atomic units of work needed to perform a task.”

The Office Action states “[a]s to claim 16” that Bukow discloses “[d]etermining necessary tasks to be performed.” Claim 16, of course, does not include this limitation. Rather, it recites the step of “determining several types of atomic units of work.” As such, the Office Action does not fairly attempt to meet the substance of the actual claim limitation. It bases a rejection on an imagined limitation that appears nowhere in the claim.

In support of its conclusion in regard to claim 16, the Office Action cites column 1, lines 33 through 37, of Bukow. This section, however, does not describe the claim limitations relating to atomic units of work:

The matching problem is equally prevalent in the employment area. For example, a contractor developing a website might need a subcontractor to develop artwork for the web site. Finding that subcontractor can be difficult and the global reach of the Internet has greatly broadened the ability to work with geographically dispersed employees.

As is readily evident, this passage of Bukow describes the use of the Internet to match projects and workers. Bukow is therefore similar to web sites that match employees with employers, such as www.monster.com, which the specification distinguishes from the invention (*see* p. 2, ¶ 4). Bukow does not describe breaking down a task into “several types of atomic units of work,” which are then parceled out to individual participants.

In particular, the reference to “artwork” as a part of developing a website is not a description of an activity that a business could not, or would not for practical reasons, further subdivide. The hypothesized “artwork” may or may not include additional work that a business would subdivide. Bukow is simply silent on the point. In addition, Bukow fails to describe at all the concept of “several types” of atomic units of work needed to perform a task. Even if the “artwork” could be considered an atomic unit of work, Bukow does not describe the step of determining different “types” of atomic units of work needed to perform a task.

Bukow is concerned with matching entire “projects” with workers. It does not expressly or inherently describe that such projects are units of work that have been divided.

This alone distinguishes claim 16 from Bukow. Applicants' specification describes an innovative system of breaking down tasks into atomic units of work and then distributing those tasks to selected participants through a robust system. This concept is entirely missing from Bukow.

Bukow, therefore, does not anticipate claim 16; it fails to describe the claimed limitation of "determining several types of atomic units of work needed to perform a task." In addition, because it fails to describe the limitation of determining atomic units of work, it similarly fails to describe the remaining limitations of the claim, such as selecting a candidate to perform each type of atomic unit of work and negotiating and paying for each atomic unit of work.

Bukow further does not describe or anticipate claims 17 or 18, which depend from claim 16, for the same reasons. In addition, claim 18 further includes "the step of determining the pool of potential candidates via an indirect message delivery process." This limitation is described in the specification as follows:

the announcement is made only to selected prospective participants, which may accept the opportunity and/or pass the opportunity to other prospective candidates. It is understood, as an empirical matter, that prospective candidates having certain qualifications will comprise a network of individuals that are positioned to identify other highly desirable candidates. The "small-world" delivery system thus may yield more productive results than a direct message delivery.

(Specification, pp. 13-14, ¶ 51.)

The Office Action asserts that Bukow, at column 8, lines 22-26, "teaches indirectly determined applicant pool." The referenced section of Bukow, however, states only that "interested" workers may contact a project creator through various modes of communication. Bukow does not describe the step of creating a pool of potential candidates through indirect means, such as an interpersonal network.

For the foregoing reasons, Bukow does not describe the subject matter of claims 16-18. The Office Action's rejection of these claims as being anticipated by Bukow should be reversed.

Rejection of Claims 19 and 21-32 under 35 U.S.C. § 103(a)

Relying on a combination of Bukow and Medquist, the Office Action dated July 27, 2006 rejected claims 19 and 21-32 as being obvious. Applicants respectfully request reversal of this rejection.

As with the conclusions relating to anticipation, the Office Action incorrectly characterizes both Bukow and the actual claim limitations at issue. In particular, the Office Action again mistakenly states that Bukow teaches “determining necessary tasks to be performed” and therefore describes several claim limitations.

For the reasons set forth above in connection with claim 16, however, Bukow does not describe actual claim limitations such as “separating the task into subparts, wherein certain of the subparts may be performed on an atomic unit basis by a pool of potential workers” (Claim 19) and “offering to the individual independent contractors in the identified group an opportunity to perform the type of atomic units of work” (Claim 21). Indeed, the Office Action does not even attempt to establish that Bukow describes these *actual* limitations. Rather, it references a step (“determining necessary tasks to be performed”) that appears nowhere in any pending claim. As such, the Office Action failed to establish a *prima facie* case of obviousness (based on Bukow or Medquist or a combination thereof) for claims 19 and 21, both of which include limitations directed to “atomic units of work.”

The Office Action also provides no motivation or reason to combine Bukow with Medquist. Rather, it simply selected the Medquist reference and then created a hypothetical combination without any explanation as to the appropriateness of this combination. Due to the absence of this required explanation, the Office Action has not established a proper *prima facie* case of obviousness.

Although the U.S. Supreme Court’s recent decision in *KSR Int’l. Co. v. Teleflex, Inc.* No. 04-1350 (U.S. Apr. 30, 2007) rejected a rigid approach to the obviousness determination, the U.S. Patent and Trademark Office, as evidenced by the memorandum issued on May 3, 2007 by Margaret Focarino, Deputy Commissioner for Patent Operations, still requires at least an identification of “the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed.” The Office Action lacks this required

identification, which effectively (and arbitrarily) denies Applicants an opportunity to challenge the conclusion that claims 19 and 21-32 are obvious.

For the foregoing reasons, the rejection of claims 19 and 21-32 based on the hypothetical combination of Bukow and Medquist should be reversed. The Office Action did not establish a prima face case of obviousness for these claims. In addition, and for similar reasons, the Office Action also did not establish the purported obviousness of claims 22-32, which depend from claim 21.

Conclusion

In summary, the present invention is not anticipated or rendered obvious from the combined teachings of Bukow or Medquist because neither reference discloses the claimed steps involving "atomic units of work." For these reasons, as well as others stated herein above, the presently pending claims are patentable over the prior art presently known to Appellants.

Appellants therefore request reversal of the presently pending rejection of claims 16-19 and 21-32.

Respectfully submitted,

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VIII. Claims Appendix

Claims 1-15 are withdrawn.

16. A method for efficiently accessing, engaging and managing human resources to perform a task, the method comprising the steps of:

determining several types of atomic units of work needed to perform a task;

announcing to a pool of potential applicants a need to have at least one type of atomic unit of work performed, wherein the work is capable of being transmitted electronically over the Internet and wherein the pool includes at least one applicant who is qualified to perform the at least one type of atomic unit of work;

selecting at least one candidate from within the pool to perform the at least one type of atomic unit of work;

negotiating a payment for each atomic unit of work with the at least one selected candidate;

paying each selected candidate the negotiated payment for each atomic unit of work performed.

17. The method of claim 16, wherein the pool of applicants is limited to those having certain predetermined credentials.

18. The method of claim 16 further comprising the step of determining the pool of potential candidates via an indirect message delivery process.

19. A method for efficiently performing a task, the method comprising the steps of:
separating the task into subparts, wherein certain of the subparts may be performed on an atomic unit basis by a pool of potential workers;

determining the type of atomic units of work needed to perform the subparts of the task that may be performed on an atomic unit basis;

selecting at least one candidate to perform each type of atomic unit of work;

receiving the work product for each performed atomic unit of work over the Internet;

paying each selected candidate for each received atomic unit of work on a predetermined basis.

21. A method for efficiently utilizing the skills of individual independent contractors, whose individual skills have been input as searchable data in an electronic database, the method comprising the steps of:

searching the database to identify a group of individual independent contractors whose skills, as indicated by the data in the database, match the criteria necessary to complete a type of atomic unit of work;

offering to the individual independent contractors in the identified group an opportunity to perform the type of atomic units of work;

selecting at least one individual independent contractor from the group to perform the type of atomic units of work;

providing the selected individual independent contractor with-uncompleted atomic units of work;

receiving the work product for each completed atomic unit of work from the selected individual independent contractor over the Internet;

paying the selected individual independent contractor for each completed atomic unit of work.

22. The method of claim 21, wherein a type of atomic unit of work is reviewing a document of predetermined length for typographical errors.

23. The method of claim 21, wherein a type of atomic unit of work is transcribing dictation of a predetermined duration.

24. The method of claim 23, wherein the predetermined duration is ten minutes.

25. The method of claim 21, wherein a type of atomic unit of work is verifying data relating to an insurance claim.

26. The method of claim 25, wherein data relating to an insurance claim includes a description of the events leading to the claim.

27. The method of claim 21, wherein an atomic unit of work is processing an invoice in an accounts payable file.

28. The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes the ability to read the English language.

29. The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes a high school diploma.

30. The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes a certification of completion of specialized training pertaining to the type of atomic unit of work.

31. The method of claim 21, wherein the criteria necessary to complete the type of atomic unit of work includes a predetermined level of prior experience in conducting the type of atomic unit of work.

32. The method of claim 31, wherein the predetermined level of prior experience is the prior completion of 100 atomic units of work of the type of atomic unit of work.

IX. Evidence Appendix

Not Applicable

X. Related Proceedings Appendix

Not Applicable